

## **REMARKS**

### **Examiner Interview**

Applicants wish to thank Examiner Jolley for the telephonic interview of Monday, April 26, 2004. The substance of that interview is incorporated with the remarks below. No agreement as to the allowability of the claims was reached during the interview.

### **Status of Claims**

Claims 1-7 and 9-48 are currently pending. Claims 1-7 and 9-48 stand rejected.

### **Amendments to the Specification**

The Examiner has indicated that the application numbers cited on pages 1 and 14 of the Applicants' specification should be updated as U.S. Patent Numbers if the applications have been patented. Also, the Examiner requests that the remaining application numbers be designated as "commonly owned." The application serial numbers that have issued have been changed to reflect the issued patent numbers. The remaining application serial numbers have been changed to reflect the fact that they are commonly owned. In light of the above amendments to the specification, applicants respectfully request the Examiner to withdraw this objection.

### **Double Patenting**

The Examiner has provisionally rejected claim 1-7 and 9-48 under the judicially created doctrine of double patenting. Applicants have filed herewith a Terminal Disclaimer to overcome the obviousness-type double patenting rejection. Applicants request that the Examiner withdraw this rejection.

## Rejections under 35 U.S.C. § 103

### Rejections over Perini

Claims 1-7, 9-12, 14, 16-19, and 21-40 stand rejected under 35 U.S.C. § 103(a) as being obvious over WO 01/40090 A2, hereinafter Perini. The Office Action asserts that Perini discloses providing a web of material, applying a wetting solution to the web to produce a wet web, and winding the wet web into a roll. The Office Action acknowledges that Perini teaches that the web should be substantially dry when it is broken. However, the Office Action maintains that it would have been obvious to break a wet web in order to achieve inferior results.

The Applicants respectfully traverse this rejection. Applicants point out that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103 as a basis for rejection of these claims. In MPEP § 2143, the three basic elements of a valid *prima facie* case of obviousness in view of a reference are presented as:

- 1) Some suggestion or motivation to modify the reference  
or to combine reference teachings;
- 2) A reasonable expectation of success in the  
modification or combination; and
- 3) A teaching or suggestion of all the claim elements in  
the reference(s).

Independent Claims 1, 18, 31 and 39 recite breaking a wet web after applying a wetting solution to the web. As acknowledged in the Office Action, Perini teaches away from breaking the web when the web is wet. Specifically, Perini says that it would be difficult, ***if not impossible***, to effectuate a successful changeover if the web is wet when it is broken, WO 01/40090, p. 9, l. 1-10. There can be no suggestion or motivation to modify the Perini method to include the breaking of a wet web in view of the teachings in the reference. As noted in

MPEP 2143.01, with reference to *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990):

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the **desirability** of the combination. [Bold emphasis added]

It is impossible for Perini to present the possibility of breaking a wet web as “desirable,” while at the same time warning the reader against breaking a wet web.

In addition, if a proposed modification would render the prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). As discussed above, Perini teaches that modifying the teachings disclosed therein to include wetting the web before it was broken would render it unsatisfactory for its intended purpose.

The Examiner also asserts that Perini teaches perforating the web at page 7, line 4; and that perforating meets the limitation of “breaking” the wet web. As noted below with respect to the Deacon et al. reference, the term “breaking” as recited in the claims cannot be equated with perforating. Regardless of the terminology, the web in Perini is perforated before it is wetted (FIG. 1), thus, even assuming that perforating and breaking are the same, failing to meet the recital of “breaking the wet web.”

### **Rejections over Deacon et al.**

Claims 1-7, 9-19, and 21-30 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,601,938 (hereinafter Deacon). Deacon discloses a roll of wet wipes comprising an elongate web substrate impregnated with a liquid composition.

Independent Claims 1 and 18 recite providing a web of material "wherein the web travels at a speed of at least 60 meters per minute." Deacon does not teach or suggest providing the web such that the web travels at a speed of at least 60 meters per minute or breaking the web after it has been wetted. Therefore, the Applicants respectfully traverse the Examiner's rejection.

The Examiner asserts that perforating and slitting the wet web, as in Deacon, meet the limitation of breaking the wet web. The Applicant's respectfully disagree. Applicant's specification defines "breaking" as the action creating a leading edge connected to the trapped portion of the web [the portion of the web pinched between the upper winding roller and the transfer show ridge] by pulling the web back or stalling the web on the smooth insert separating, or breaking, the perforation. See page 24, lines 14-30 of the Applicant's specification. Clearly, as used in the instant application, "breaking" and "perforating" have separate and distinct meanings.

Moreover, Claim 18 includes the steps of "perforating the web" and "breaking the wet web." In order to avoid redundancy in the claim language, these two words must be interpreted as having distinct and individual meanings. Also, Claim 31 includes the step of breaking the wet web and forming a cigarette from the leading edge of the break. This too, must be differentiated from a perforation, as disclosed in Deacon. Because Deacon fails to teach or suggest each and every element of the claimed invention, Applicants respectfully request the Examiner to withdraw this rejection.

Deacon also does not disclose providing a web, wherein the web travels at a speed of at least 60 meters per minute. As in Perini above, the Examiner is attempting to use an improper "obvious to try" rationale. It is improper to render obvious that which might have been obvious to try when the prior art gives no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful. MPEP § 2145(X)(B). The Examiner admits that Deacon lacks any teaching of the speed at which the web travels. The speed cannot be a cause-effective variable, obvious from Deacon, because

Deacon fails to teach or even consider the breaking of the wet web while winding the roll. Because Deacon fails to teach or suggest the speed at which a wet web could travel, Applicants respectfully request this rejection be withdrawn.

**Rejections over Perini in view of Deacon et al.**

Claims 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Perini and further in view of Deacon. The Examiner asserts that Perini fails to teach the specifics of the web used to form its wet web, and specifically using a web comprising a wet-formed basesheet or water-dispersible binder. Claims 13 and 15 depend from Claim 1, discussed above. Neither Perini nor Deacon teaches or suggests "breaking a wet web" or "providing a web, wherein the web travels at a speed of at least 60 meters per minute," as discussed above. Because neither reference, either alone or in combination teach or suggest each and every element of the claimed invention, Applicants respectfully request the Examiner to withdraw this rejection.

Further, Deacon does not disclose that the acrylic resin is water dispersible. Rather, this property appears to have been supplied from the Examiner's personal knowledge. As noted in the MPEP 2144.03, with reference to 37 CFR 1.104(d)(2):

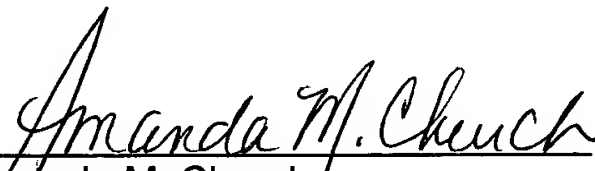
When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated **as specifically as possible**, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. [Emphasis added]

Accordingly, applicants hereby request, under 37 CFR 1.104(d)(2), that the Examiner provide an affidavit in support of the assertions made based on the Examiner's personal knowledge.

### SUMMARY

Pending Claims 1-7 and 9-48 as amended are patentable. Applicants respectfully request the Examiner grant early allowance of this application. The Examiner is invited to contact the undersigned attorneys for the Applicant via telephone if such communication would expedite this application.

Respectfully submitted,

  
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